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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
09/628,496	07/28/2000	Mark Bresnan	F-192	3808
919 7590 08/19/2009 PITNEY BOWES INC. 35 WATERVIEW DRIVE MSC 26-22 SHELTON, CT 06484-3000				
EXAMINER BORISSOV, IGOR N				
ART UNIT 3628		PAPER NUMBER		
NOTIFICATION DATE 08/19/2009		DELIVERY MODE ELECTRONIC		

Please find below and/or attached an Office communication concerning this application or proceeding.

The time period for reply, if any, is set in the attached communication.

Notice of the Office communication was sent electronically on above-indicated "Notification Date" to the following e-mail address(es):

iptl@pb.com

**Advisory Action
Before the Filing of an Appeal Brief**

Application No.

09/628,496

Applicant(s)

BRESNAN ET AL.

Examiner

Igor N. Borissov

Art Unit

3628

--The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

THE REPLY FILED 24 July 2009 FAILS TO PLACE THIS APPLICATION IN CONDITION FOR ALLOWANCE.

1. ☒ The reply was filed after a final rejection, but prior to or on the same day as filing a Notice of Appeal. To avoid abandonment of this application, applicant must timely file one of the following replies: (1) an amendment, affidavit, or other evidence, which places the application in condition for allowance; (2) a Notice of Appeal (with appeal fee) in compliance with 37 CFR 41.31; or (3) a Request for Continued Examination (RCE) in compliance with 37 CFR 1.114. The reply must be filed within one of the following time periods:

- a) ☒ The period for reply expires 3 months from the mailing date of the final rejection.
b) ☐ The period for reply expires on: (1) the mailing date of this Advisory Action, or (2) the date set forth in the final rejection, whichever is later. In no event, however, will the statutory period for reply expire later than SIX MONTHS from the mailing date of the final rejection.
Examiner Note: If box 1 is checked, check either box (a) or (b). ONLY CHECK BOX (b) WHEN THE FIRST REPLY WAS FILED WITHIN TWO MONTHS OF THE FINAL REJECTION. See MPEP 706.07(f).

Extensions of time may be obtained under 37 CFR 1.136(a). The date on which the petition under 37 CFR 1.136(a) and the appropriate extension fee have been filed is the date for purposes of determining the period of extension and the corresponding amount of the fee. The appropriate extension fee under 37 CFR 1.17(a) is calculated from: (1) the expiration date of the shortened statutory period for reply originally set in the final Office action; or (2) as set forth in (b) above, if checked. Any reply received by the Office later than three months after the mailing date of the final rejection, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

NOTICE OF APPEAL

2. ☐ The Notice of Appeal was filed on _____. A brief in compliance with 37 CFR 41.37 must be filed within two months of the date of filing the Notice of Appeal (37 CFR 41.37(a)), or any extension thereof (37 CFR 41.37(e)), to avoid dismissal of the appeal. Since a Notice of Appeal has been filed, any reply must be filed within the time period set forth in 37 CFR 41.37(a).

AMENDMENTS

3. ☒ The proposed amendment(s) filed after a final rejection, but prior to the date of filing a brief, will not be entered because
(a) ☐ They raise new issues that would require further consideration and/or search (see NOTE below);
(b) ☐ They raise the issue of new matter (see NOTE below);
(c) ☒ They are not deemed to place the application in better form for appeal by materially reducing or simplifying the issues for appeal; and/or
(d) ☐ They present additional claims without canceling a corresponding number of finally rejected claims.

NOTE: See Continuation Sheet. (See 37 CFR 1.116 and 41.33(a)).

4. ☐ The amendments are not in compliance with 37 CFR 1.121. See attached Notice of Non-Compliant Amendment (PTOL-324).
5. ☐ Applicant's reply has overcome the following rejection(s): _____.
6. ☐ Newly proposed or amended claim(s) _____ would be allowable if submitted in a separate, timely filed amendment canceling the non-allowable claim(s).
7. ☒ For purposes of appeal, the proposed amendment(s): a) ☒ will not be entered, or b) ☐ will be entered and an explanation of how the new or amended claims would be rejected is provided below or appended.
The status of the claim(s) is (or will be) as follows:
Claim(s) allowed: _____.
Claim(s) objected to: _____.
Claim(s) rejected: 1-21, 23-40 and 42-52.
Claim(s) withdrawn from consideration: _____.

AFFIDAVIT OR OTHER EVIDENCE

8. ☐ The affidavit or other evidence filed after a final action, but before or on the date of filing a Notice of Appeal will not be entered because applicant failed to provide a showing of good and sufficient reasons why the affidavit or other evidence is necessary and was not earlier presented. See 37 CFR 1.116(e).
9. ☐ The affidavit or other evidence filed after the date of filing a Notice of Appeal, but prior to the date of filing a brief, will not be entered because the affidavit or other evidence failed to overcome all rejections under appeal and/or appellant fails to provide a showing of good and sufficient reasons why it is necessary and was not earlier presented. See 37 CFR 41.33(d)(1).
10. ☐ The affidavit or other evidence is entered. An explanation of the status of the claims after entry is below or attached.

REQUEST FOR RECONSIDERATION/OTHER

11. ☒ The request for reconsideration has been considered but does NOT place the application in condition for allowance because: Please see attached.
12. ☐ Note the attached Information Disclosure Statement(s). (PTO/SB/08) Paper No(s). _____
13. ☐ Other: _____.

/Igor N. Borissov/
Primary Examiner, Art Unit 3628

Continuation of 3. NOTE:

Contrary to Applicant's statement (Remarks/Arguments, 3rd line) Claim 20 is not amended to overcome the informalities noted in the last Office Action of 6/15/2009.

Continuation of 11. NOTE:

Applicant argues that Cordery patent is not available as prior art against the instant application under 35 USC § 103(c), because the instant application and Cordery's U.S. Patent No. 5,628,249 assigned to Pitney Bowes Inc., were at the time of the invention of the present application, commonly owned by or subject to an obligation of assignment to the same entity, namely Pitney Bowes Inc.

In response to this argument it is noted that Common Ownership of Assignee Prior Art Exclusion Under 35 U.S.C. 103(c), which disqualified subject matter under former 35 U.S.C. 103 via 35 U.S.C. 103(e) as prior art, was enacted on November 29, 1999, which is later than the effective date of the instant application, and, therefore, is ineffective for the instant application.

Applicant argues that Humes is a presort house that does not disclose a second printer that prints documents in accordance with characteristics selected at a first node.

In response to this argument it is noted that Cordery discloses this feature at C. 4, L. 9-16.

Applicant argues that the art cited by the Examiner for claim 1 and those claims dependent thereon, does not disclose or anticipate steps d, e, and g of claim 1, namely,

- (d) transmitting electronically said print job to a terminal node wherein said terminal node is not co-located with, nor under the control of, said first node;
- (e) receiving said print job at said terminal node, said terminal node for receiving said print job and for directing said print job to a mail production means for producing said mail piece, said mail production means further comprising: (i) a first printer; and (ii) a second printer;
- (g) printing on said second printer said document, wherein said document is printed in accordance with characteristics selected at said first node;

In response to this argument it is noted that Cordery teaches:

- (d) transmitting electronically said print job to a terminal node (C. 4, L. 7-9);
- (i) a first printer (C. 4, L. 33-34);
- (ii) a second printer (C. 4, L. 9-10);
- (g) printing on said second printer said document, wherein said document is printed in accordance with characteristics selected at said first node (C. 4, L. 9-16).

While Cordery does not teach that said terminal node, to which said print job is transmitted, is not co-located with, nor under the control of, said first node, Humes discloses this feature (See C. 3, L. 30-49).

Applicant argues that, regarding claim 15, the prior art of record does not allow one to control the time for producing a mail piece consisting of a document and an envelope that utilize transmitting means to transmit a mailing to second data processing means that are not co-located with or under the control of first data processing means.

In response to this argument it is noted that the "control the time" features upon which applicant relies in claim 15 is not recited in the rejected claim. Although the claims are interpreted in light of the specification, limitations from the specification are not read into the claims. See *In re Van Geuns*, 988 F.2d 1181, 26 USPQ2d 1057 (Fed. Cir. 1993).

Applicant argues that, regarding claim 15, the prior art of record does not teach elements b, c, and e.

In response to this argument it is noted that Cordery teaches:

- (b) transmission means for transmitting said mailing to a second data processing means (C. 4, L. 7-9);
- (c) second data processing means for receiving said mailing and downloading said mailing to a plurality of printer means comprising a first printer and a second printer (C. 4, L. 7-10, 33-34);
- (e) second printer means comprising said second printer for printing said document to media selected at said first data processing means (C. 4, L. 9-10).

While Cordery does not teach that said terminal node, to which said print job is transmitted, is not co-located with, nor under the control of, said first node, Humes discloses this feature (See C. 3, L. 30-49).

Applicant argues that, regarding claim 20, the art cited by the Examiner does not disclose or anticipate the following steps of claim 20 as amended, namely
creating a document and storing said document in electronic form; transmitting said document, said address list and said characteristics to a terminal node wherein said terminal node is not co-located with, nor under the control of, said first node; printing said document in accordance with one or more of said characteristics selected at said first node; providing said printed envelope with evidence of postage payment.

In response to this argument it is noted that Cordery teaches:

- creating a document and storing said document in electronic form (C. 3, L. 25-46);
- transmitting said document, said address list and said characteristics to a

terminal node (C. 4, L. 7-9);
printing said document in accordance with one or more of said characteristics
selected at said first node (C. 4, L. 9-16).

While Cordery does not teach that said terminal node, to which said print job is transmitted, is not co-located with, nor under the control of, said first node, Humes discloses this feature (See C. 3, L. 30-49).

Applicant argues that, regarding claim 38, the art cited by the Examiner does not disclose a system for producing a mail piece that has second data processing means for electronically receiving said selected document, address list and characteristics and directing said selected document, address list and characteristics to a mail production means, wherein said second data processing means is not co-located with, nor under the control of, said first data processing means; said mail production means comprising first means for printing said selected document in accordance with one or more of said selected characteristics, second means for printing each of said destination addresses to a corresponding envelope, means for printing said corresponding envelope with evidence of postage payment, and means for inserting said printed document into a corresponding printed envelope.

In response to this argument it is noted that Cordery teaches a system for producing a mail piece comprising:
second data processing means for electronically receiving said selected document, address list and characteristics and directing said selected document, address list and characteristics to a mail production means (C. 4, L. 7-10, 33-34);
said mail production means comprising first means for printing said selected document in accordance with one or more of said selected characteristics (C. 4, L. 9-10), second means for printing each of said destination addresses to a corresponding envelope (C. 4, L. 33-34);
means for printing said corresponding envelope with evidence of postage payment (franking suggests this feature) (C. 5, L. 24-25); and
means for inserting said printed document into a corresponding printed envelope (C. 5, L. 12-14).
While Cordery does not teach that said second data processing means is not co-located with, nor under the control of, said first data processing means, Humes discloses this feature (See C. 3, L. 30-49).

The remaining applicant's arguments essentially repeat the arguments presented above; therefore, the responses presented by the examiner above are equally applicable to the remaining applicant's arguments.